

### **REMARKS**

Upon entry of the present amendments, claims 1 and 4-27 constitute the pending claims in the present application. Claims 2-3 were previously cancelled. Claims 1 and 4-18 stand rejected. Claims 19-27 are newly added.

#### **Telephonic Interview and Amendments**

Applicants appreciate the time and attention of Examiner Gilbert during the telephonic interview of August 16, 2007. During the interview, Applicants requested clarification as to the status of the rejection under 35 U.S.C 101 from the Office Action of September 15, 2006. The Office indicated that this rejection has been withdrawn. The outstanding rejections over U.S. 6,042,534 to Gellman et al. ("Gellman") and U.S. Published Patent Application No. 2004/0225181 to Chu et al. ("Chu") were also discussed. In particular, Applicants noted that in the outstanding Final Office Action that the Office interprets "sleeve," as recited in claims 1 and 17, to include coatings as disclosed in Gellman and U.S. Provisional Patent Application No. 60/465,722 (the "Chu provisional"). Applicants and the Office agreed that amending these claims to recite the original "casing" language combined with disclaimer of "coatings" would distinguish the recited casings from the reference coatings. The Office acknowledged that such an amendment to claims 1 and 17 would overcome the outstanding rejections over Gellman and would be considered in regard to the outstanding rejections over Chu.

Accordingly, Applicants have amended claims 1 and 17 to more particularly define the presently claimed invention. In particular, the original "casing" language from these claims has been restored and the subject matter regarding coatings from original claim 3 has been disclaimed. As a result, Applicants have also amended claims 15 and 16 to correct antecedence.

#### **New Claims**

Applicants have reinstituted original claim 2 as claim 19 and added new claims 20-27. Support for claim 20 can be found in the specification as originally filed, at least, for example, in the first paragraph on page 5. Support for claims 21-24 can be found in the specification as originally filed, at least, for example, in the second paragraph on page 4 and in FIG. 2. Support for claims 25-26 can be found in the specification as originally filed, at least, for example, in the second paragraph

on page 6 and in FIG. 4. Support for new claim 27 can be found in the specification as originally filed, at least, for example, in the first paragraph on page 5 and in FIG. 1, which depicts space between sling ends 124A and 124B and the sleeve ends 132A and 132B sufficient for the sling to be movable with respect to the sleeve.

Applicants assert the present amendments to claims 1 and 15-17 and newly added claims 19-27 do not add new matter. Applicants reserve the right to pursue the subject matter of the claims as unamended in one or more continuation and/or divisional applications.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Office will be addressed below in the order they appear in the Office Action.

1. Claim Rejections – 35 U.S.C. 102(b) – Claims 1, 7, 9-11 and 13-18 over Gellman

Claims 1, 7, 9-11 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gellman. Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

The Office considers the coating recited in column 8, lines 3-13 of Gellman to be a sleeve as recited in unamended claims 1 and 17. As noted above, Applicants have amended claims 1 and 17 to disclaim any casings that may be a coatings. As such, any coatings recited in Gellman that the Office considers to be sleeves or casings are not within the ambit of claims 1 and 17. As Gellman has only been shown to teach coatings, this reference has not been shown to teach all the features of claims 1 and 17. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see MPEP 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Since Gellman has not been shown to teach all the features of claims 1 and 17, this reference cannot be said to anticipate these claims or those dependent thereon. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

2. Claim Rejections – 35 U.S.C. 102(b) – Claims 1 and 13-18 over Chu

Claims 1 and 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Chu. Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

In the Office Action of September 15, 2006, in issuing a 102(e) rejection over Chu, the Office relied on the sleeve 18 of Chu (see paragraph 0066 of Chu) and considered this disclosure to teach the sleeve recited in unamended claim 1. In Applicants' Reply dated March 14, 2007, Applicants pointed out that the sleeve 18 of Chu is subject matter that is not found in the Chu priority document, the Chu provisional, which was filed April 25, 2003. As such, this subject matter is only entitled to the filing date of Chu, April 26, 2004. Considering the present application has a filing date of July 31, 2003, the portions of Chu that are not found in the Chu provisional, such as the sleeve 18, do not qualify as prior art under 35 U.S.C. 102(e). In the outstanding Final Office Action (see page 5), the Office responds that the Chu provisional, though not teaching a "sleeve," teaches a coating on page 859 and again asserts that a coating is analogous to the sleeve recited in unamended claims 1 and 17.

Applicants assert that the remarks above with respect to the 102(b) rejection over Gellman apply equally to the instant 102(e) rejection over Chu, namely, that as coatings have been disclaimed from claims 1 and 17, the coatings recited in the Chu provisional do not fall within the ambit of these claims. Since Chu, by way of the Chu provisional, has only been shown to teach coatings, this reference has not been shown to teach all the features of claims 1 and 17 and thus cannot be said to anticipate these claims or those dependent thereon. *Verdegaal, supra*. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

3. Claim Rejections – 35 U.S.C. 103(a) – Claims 4-5, 8 and 12 over Gellman in view of Shekalim and Ochoa

Claims 4-6, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman in view of U.S. 6,971,813 to Shekalim et al. ("Shekalim") and U.S. 5,935,172 to Ochoa et al. ("Ochoa"). Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

As explained above, Gellman has not been shown to teach or suggest all the features of amended claim 1, from which claims 4-6, 8, and 12 depend. Applicants also assert that the teachings of Shekalim and Ochoa do not teach or suggest all of such features. Shekalim discloses the application of “liquid or semi-liquid” coating materials to a prosthesis. Shekalim, column 2, lines 7-9. But Shekalim does not teach or suggest a biocompatible casing, wherein the casing is not a coating. Ochoa also does not teach or suggest this feature. Accordingly, Shekalim and Ochoa, even if combined with the teachings of Gellman, do not teach or suggest all the features of claim 1.

Pursuant to MPEP 2142, “[t]o establish a prima facie case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As Gellman, Shekalim, and Ochoa, either alone or in combination, fail to teach or suggest all the features of claim 1, this claim and those dependent thereon are not obvious over Gellman in view of Shekalim and Ochoa. Applicants consequently request reconsideration and withdrawal of the present rejection of claims 4-6, 8, and 12.

4. Claim Rejections – 35 U.S.C. 103(a) – Claims 4-12 over Chu in view of Shekalim and Ochoa

Claims 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu in view of Shekalim and Ochoa. Applicants traverse the rejection to the extent that it is maintained over the claims as currently amended.

The remarks above for the 103(a) rejection over Gellman in view of Shekalim and Ochoa apply equally to the instant 103(a) rejection over Chu in view of Shekalim and Ochoa. Notably, the portions of Chu entitled to the filing date of the Chu provisional have not been shown to teach or suggest all the features of amended claim 1, from which claims 4-12 depend, and Shekalim and Ochoa fail to cure this deficiency. Accordingly, Shekalim and Ochoa, even if combined with the teachings of Chu entitled to the filing date of the Chu provisional, do not teach or suggest all the features of claim 1, and therefore this claim and those dependent thereon are not obvious over Chu in view of Shekalim and Ochoa. *Vaeck, supra*. Applicants consequently request reconsideration and withdrawal of the present rejection of claims 4-12.

Applicants previously advanced that the claimed invention and Chu were, at the time the claimed invention was made, subject to an obligation of assignment to Scimed Life Systems, Inc. As a result, under 35 U.S.C. 103(c), the subject matter disclosed in Chu is not available as prior art for a rejection under 35 U.S.C. 103(a) and therefore cannot be combined with the teachings of Shekalim and Ochoa. During the August 16, 2007 telephonic interview, the Office contended that the assignment of Chu to Scimed Life Systems, Inc. was recorded on July 13, 2004 and that the filing date of the present application is July 31, 2003, so that the requirements of 35 U.S.C. 103(c) did not appear to be satisfied. Applicants respectfully pointed out that 35 U.S.C. 103(c) provides that the claimed invention and the subject matter of Chu must be subject to an obligation of assignment and not necessarily actually assigned at the time the presently claimed invention was made. That the subject matter of Chu was indeed subsequently assigned to Scimed Life Systems, Inc. supports that such an obligation of assignment was in place at the time of filing the present application. Hence, Applicants reaffirm their contention that under 35 U.S.C. 103(c) the subject matter disclosed in Chu is not available as prior art for a rejection under 35 U.S.C. 103(a). Should any 103(a) rejections over Chu be maintained, if necessary, Applicants stand ready to submit additional evidence that an obligation of assignment to Scimed Life Systems, Inc. was in place at the time of filing the present application.

5. *Withdrawal of Prior Rejections*

Applicants note with appreciation the withdrawal of the prior rejection under 35 U.S.C. 101 of claims 14-16.

**CONCLUSION**

In view of the above remarks and amendments, Applicants believe the pending application is in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000.

Reply dated September 14, 2007  
In Reply to Final Office Action of June 19, 2007

Application No. 10/631,364  
Docket No.: MIY-P01-032

Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission to Deposit Account No. 18-1945, under Order No. MIY-P01-032 from which the undersigned is authorized to draw.

Dated: September 14, 2007

Respectfully submitted,

By 

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